



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/445,133	03/13/2000	AHMET MURSIT ESKICIOGLU	RCA88674	9526

24498 7590 05/19/2005

THOMSON LICENSING INC.
PATENT OPERATIONS
PO BOX 5312
PRINCETON, NJ 08543-5312

EXAMINER

KLIMACH, PAULA W

ART UNIT	PAPER NUMBER
----------	--------------

2135

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/445,133	Applicant(s) ESKICIOGLU, AHMET MURSIT	
	Examiner Paula W. Klimach	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

TL

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed on 01/28/05. Applicant amended Claims 1. The amendment filed on 01/28/05 have been entered and made of record. Therefore, presently pending claims are 1-20.

Response to Arguments

Applicant's arguments filed 01/28/05 have been fully considered but they are not persuasive because of following reasons.

Applicant argued that Wasilewski reference does not teach or suggest an encrypted message, which message includes a descrambling key and the recited event information. This is not found persuasive. The definition of message is a communication by signals. Therefore the system of Wasilewski discloses communicating encrypted event information (column 12 lines 34-62) and descrambling key (column 12 lines 1-32).

In reference to claim 15, Applicant argued that claim 15 recites a symmetric key encrypted using public key cryptography. However, claim 15 recites "...decrypting, in said smart card, said message using a private key of said smart card to obtain event information and a symmetric key..." Claim 15 discloses the public key is used for decrypting said digital signature. The use of a public key is used in an asymmetric key encryption process as opposed to a symmetric key encryption.

The examiner asserts that Wasilewski and Pinder do teach or suggest the subject matter broadly recited in independent Claims 15 and 18. The reference Hendricks discloses the

Art Unit: 2135

limitations that are not disclosed by Wasilewski due to amendments made by the applicant, are covered by the. Dependent Claims 2-14, 16-17, and 19-20 are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in this office action.

Accordingly, rejections for claims 15-20 are respectfully maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski et al (6,424,714 B1) and Hendricks et al (5,600,364).

In reference to claim 1, Wasilewski discloses a system that provides conditional access to services (abstract), wherein the user can select an event (column 30 lines 32-47. The agent responds to the customer order by sending an EMM containing the necessary entitlement information (column 30 lines 48-67). Wasilewski further discloses the secure delivery of the event (programs) from the service provider to the customer set top unit (abstract). Wasilewski discloses receiving at the device the encrypted message (column 7 lines 1-17). In the system of Wasilewski further decrypts the encrypted message to obtain a descrambling key, the program is scrambled with the descrambling key for preventing unauthorized access to the event and descrambling the selected event using the descrambling key (Fig. 4).

Wasilewski does not expressly disclose indicating the events that are available to the customer in the form of an electronic list of events.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to indicate the customer the types of events that are available in the form of a list of events. One of ordinary skill in the art would have been motivated to do this because a list is an organized and simple way of communicating information.

Although Wasilewski discloses the use of encrypted events, Wasilewski does not disclose the contents of the event information including at least one of a channel identity, date and time stamp, event identity and payment amount corresponding to said associated event.

Hendriks discloses the contents of the event information that comprise at least the channel ID (column 20 lines 4-18).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the event information as disclosed by Hendriks in the system of Wasilewski. One of ordinary skill in the art would have been motivated to do this because the information about the event enables the service provider to charge the user.

Claims 15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski et al (6,424,714 B1) in view of Pinder et al (5,742,677).

In reference to claim 15 and 18, Wasilewski discloses a system that provides conditional access to services (abstract), wherein the user can select an event (column 30 lines 32-47. The agent responds to the customer order by sending an EMM containing the necessary entitlement information (column 30 lines 48-67). Wasilewski further discloses the secure delivery of the

Art Unit: 2135

event (programs) from the service provider to the customer set top unit (abstract). Wasilewski discloses receiving at the device the encrypted message (column 7 lines 1-17). In the system of Wasilewski further decrypts the encrypted message to obtain a descrambling key, the program is scrambled with the descrambling key for preventing unauthorized access to the event and descrambling the selected event using the descrambling key (Fig. 4).

Wasilewski does not expressly disclose indicating the events that are available to the customer in the form of an electronic list of events.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to indicate the customer the types of events that are available in the form of a list of events. One of ordinary skill in the art would have been motivated to do this because a list is an organized and simple way of communicating information.

However Wasilewski do not disclose the use of digital certificates in an electronic program guide.

Pinder discloses the use of the private key used for digital signatures (column 5 lines 33-34).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use the private key for a digital signature created using a private key as in Pinder in the system of Nagel. One of ordinary skill in the art would have been motivated to do this because the digital signature operations provide authentication (Pinder column 5 lines 34-35).

Claims 2-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski, Pinder, and Hendricks in view of Vancelette.

In reference to claim 2, the steps of decrypting said message, receiving said selected event, and descrambling said selected event are performed in a smart card coupled to the device (column 9 lines 26-33). The message being encrypted using a public key associated with said smart card and said step of decrypting uses a private key associated with and stored in said smart card, Vancelette suggests that this data is encrypted on the smart card since in the downloadable form the data is encrypted with the other data (column 6 lines 57-65).

In reference to claim 3, said message further comprises event information, said event information being decrypted using said private key (column 9 lines 54-67 in combination with column 6 lines 56-64).

In reference to claim 4, the event information is stored where the step is performed in the smart card (column 9 line 26-30). The information is downloaded to the terminals memory, the smart card has memory also and is situated at the terminal and is therefore available memory for the storage of the downloaded information.

In reference to claim 5, the smart card has a card body having a plurality of terminals arranged on a surface of said card body in accordance with one of ISO 7816 and PCMCIA card standards. It is inherent that the card body has terminals on its body for connection to the card reader for accessing the memory of the card.

In reference to claim 6, authenticating said list of events to verify the origin of said message. The events in the list are authenticated by the virtue of the list being encrypted by the service provider. The terminal then decrypts the packets with the corresponding key. This

Art Unit: 2135

implies that only those with the key that corresponds the key of the service provider can decrypt the list and therefore the information comes from the service provider (column 9 lines 4-6).

In reference to claim 8, event information comprises channel identification data, event identity data, date and time stamp data, and billing data (column 2 lines 59-65).

In reference to claim 9, further comprising the step of storing said event information, wherein said step of storing said event information is performed in said device (column 9 lines 27-30).

In reference to claims 13 and 14, said event information is used within said device to update said user's account information (column 2 lines 59-65).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use the smart card as in Vancelette in the system of Wasilewski. One of ordinary skill in the art would have been motivated to do this because smart cards are small and portable and have the processing power to perform encryption.

In reference to claims 7, Pinder discloses the use of the private key used for digital signatures (column 5 lines 33-34).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use the private key for a digital signature created using a private key as in Pinder in the system of Wasilewski. One of ordinary skill in the art would have been motivated to do this because the digital signature operations provide authentication (Pinder column 5 lines 34-35).

In reference to claim 10, digital signature, said second public key and said second private key are issued by an independent certificate authority and are associated with said list provider (Pinder column 10 lines 16-20).

In reference to claim 11, said device is a digital television. The device suggested by Vancelette is a display device, 80, a digital television is a display device and is therefore the device suggested by Vancelette.

In reference to claim 12, said device is a set-top box (column 6 lines 43-45).

Claims 16-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski and Pinder in view of Vancelette.

In reference to claims 16 and 19, the device is a set-top box (column 6 lines 43-45).

In reference to claims 17 and 20, the device is a digital television. The device suggested by Vancelette is a display device, 80, a digital television is a display device and is therefore the device suggested by Vancelette.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

Art Unit: 2135

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W. Klimach whose telephone number is (571) 272-3854. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PWK
Monday, May 16, 2005

HS
AU 2135